



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/916,635

07/27/2001

Paul G. Allen

4000.2.44

1204

32641

7590

10/31/2006

DIGEO, INC C/O STOEL RIVES LLP  
201 SOUTH MAIN STREET, SUITE 1100  
ONE UTAH CENTER  
SALT LAKE CITY, UT 84111

EXAMINER

DESIR, JEAN WICEL

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/916,635	<b>Applicant(s)</b> ALLEN ET AL.	
	<b>Examiner</b> Jean W. Désir	<b>Art Unit</b> 2622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 8/9/06 (RCE).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,6-8,10,11 and 13-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-8,10,11 and 13-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 6-8, 10, 11, 13-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terakado et al (US 6,246,441) in view of Elliott et al (6,442,328).

#### **Claim 1:**

Terakado discloses:

“A wireless receiver for receiving a play list from the digital video recorder, the play list comprising television programs previously recorded by the digital video recorder; an integrated display screen for displaying the play list to a user”, see Fig. 1 items 1, 9, 13, Figs. 2, 9, where a wireless receiver receives a play list that comprises previously recorded television programs and the play list is displayed to a user on an integrated display screen (Figs. 9, 2);

“a plurality of user controls for controlling the digital video recorder, a least one user control for receiving a selection of a television program from the play list displayed on the integrated display screen”, see Figs. 2, 9;

“and wireless transmitter for transmitting an indication of the selected television program to the digital video recorder to initiate playback of the selected television

program", see Fig. 3 item 1e which is a wireless transmitter/receiver, col. 7 line 66 to col. 8 line 3 where payback can initiate;

the difference between the claimed invention and Terakado's disclosure is that a **digital** video recorder is not explicitly shown in Terakado's disclosure, as claimed.

However Terakado initiates recording/playback of selected television program on a video recorder (Fig. 1 items 9, 13) connected to an entertainment system; and DVR (digital video recorder) is a notoriously well known device in the art- as evidence see the reference to Elliott at Fig. 2, 3 item 200 which shows a digital video recorder integrated into a television entertainment system, where play list comprising television programs previously recorded can be received (see Elliott also at col. 1 lines 28-31, col. 4 line 40 to col. 5 line 6)- used in entertainment system for making video recording and/or playback more convenient; because of these teachings an artisan would be motivated to combine the references to arrive at the claimed invention; this combination would result in a system that has a remote control device with an integrated display screen for controlling, inter alia, a digital video recorder; and would result in making video recording and/or playback more convenient; and no interference with television viewing would happen (see Terakado at col. 9 line 53). Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claim 6 is disclosed, Terakado at Figs. 2, 9.

Claim 7 is disclosed, see Terakado at Fig. 9, col. 9 lines 61-67, col. 10 line 42 to col. 11 line 24, and Elliott is capable of displaying recording list.

Art Unit: 2622

Claim 8 is disclosed, see Terakado at col. 9 lines 61-67, col. 10 line 42 to col. 11 line 24, Elliott at col. 4 line 40 to col. 5 line 13.

Claims 10, 11 are disclosed in view of the above combination because the remote control can control the digital video recorder, see Elliott at Figs. 2, 3 items 144, 200, col. 4 lines 40-51, and Terakado at Figs. 9, 10, col. 11 lines 21-24.

Claim 13 is disclosed, see Terakado at Figs. 2, 3 item 1f.

**Claim 14:**

Terakado discloses:

A digital video recorder (Fig. 1 items 9, 13) comprising:

“a wireless transmitter for transmitting a list of television programs to a remote control device”, see Figs. 1, 5, 6, items 10, 14;

“a wireless receiver for receiving a selection of a listed television program from the remote control device”, see Figs. 1, 5, 6, items 10, 14;

“and a recording and playback subsystem for selectively recording or playing back the selected television program”, see col. 9 lines 61-67, col. 11 lines 21-24; and a remote control device (Fig. 1 item 1) for the digital video recorder (Fig. 1 items 9, 13) comprising:

“a wireless receiver for receiving the list of television programs from the digital video recorder; an integrated display screen for displaying the list to a user”, see Fig. 3 item 1e, Figs. 2, 9;

“a plurality of user controls for controlling the digital video recorder, a least one user control for receiving a selection of a listed television program from the user”, see Figs. 2, 9;

“and wireless transmitter for transmitting an indication of the selected television program to the digital video recorder to initiate recording of the selected television program from a live broadcast or playback of a previously-recorded copy of the selected television program”, see Fig. 3 item 1e, col. 11 lines 21-24, col. 9 lines 61-67, col. 10 lines 42-50;

the difference between the claimed invention and Terakado's disclosure is that a **digital** video recorder is not explicitly shown in Terakado's disclosure as claimed. However Terakado initiates recording/playback of selected television program on a video recorder (Fig. 1 items 9, 13) connected to an entertainment system; and DVR (digital video recorder) is a notoriously well known device in the art- as evidence see Elliott reference at Fig. 2, 3 item 200 which shows a digital video recorder integrated into a television entertainment system, where list of television programs previously recorded can be received (see Elliott also at col. 1 lines 28-31, col. 4 line 40 to col. 5 line 6)- used in entertainment system for making video recording and/or playback more convenient; because of these teachings an artisan would be motivated to combine the references to arrive at the claimed invention; this combination would result in a system that has a remote control device with an integrated display screen for controlling, inter alia, a digital video recorder; and would result in making video recording and/or playback more convenient; and no interference with television viewing would happen

(see Terakado at col. 9 line 53). Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claim 15:

“an encoder for digitally encoding a television program in a compressed format”,  
see Elliott at Fig. 3 item 216;

“a mass storage device for storing the encoded television program”, see Elliott at  
Fig. 3 item ROTATING STORAGE DRIVE;

“a decoder for decoding a television program retrieved from the mass storage  
device”, see Elliott at Fig. 3 item 122;

“and a display controller displaying the decoded television program on an  
external device”, see Elliott at Fig. 3 items 120, 300.

Claim 16 is disclosed, see Elliott at col. 3 lines 35-36.

Claims 17-20 are disclosed, see Elliott at col. 4 lines 5-15, 52-65.

Claims 21, 22 are disclosed, see Terakado at Fig. 9, Elliott at col. 4 lines 52-60.

Claims 23-25 are disclosed, see Terakado at Figs. 2, 9, Elliott at col. 4 line 40 to col. 5  
line 6.

Claims 26, 27 are rejected for the same reasons as claims 7, 8.

Claim 28 is disclosed, see Terakado at col. 9 lines 61-67, col. 10 line 42 to col. 11 line  
24, Elliott at col. 4 line 40 to col. 5 line 13.

Claims 29, 30 are rejected for the same reasons as claims 10, 11.

Claim 31 is disclosed, see Terakado at col. 11 lines 21-24, and Elliott at col. 4 lines 40-  
43.

Claim 32 is rejected for the same reasons as claim 13.

**Claim 33** is rejected for the same reasons as claim 1.

Claims 34-39 are rejected for the same reasons as claims 21, 22, 24, 26, 28, 29.

**Claim 40** is rejected for the same reasons as claim 14.

Claims 41, 43 are rejected for the same reasons as claim 15.

Claim 42 is rejected for same the reasons as claim 16.

Claims 44-51 are rejected for the same reasons as claims 17-22, 24, 26.

**Claim 52** is rejected for the same reasons as claim 1.

**Claim 53** is rejected for the same reasons as claim 14.

### ***Response to Arguments***

3. Applicant's arguments have been fully considered but they are moot in view of new interpretation of the references necessitated by the amendment.

### **Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean W. Désir whose telephone number is (571) 272 7344. The examiner can normally be reached on 5/4/9 - First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Ometz can be reached on (571) 272 7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JWD**  
**Oct. 27, 06**



DAVID OMETZ  
SUPERVISORY PATENT EXAMINER